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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,687	06/21/2001	Steve O'Halloran	15-925 4983	8654

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EXAMINER
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FISCHETTI, JOSEPH A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/886,687

**Applicant(s)**

O'HALLORAN ET AL.

**Examiner**

Joseph A. Fischetti

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-32 is/are pending in the application.  
4a) Of the above claim(s) 9-16 and 18-32 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8,33,34 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

Claims 9-16,18-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/23/04.

First, Applicant needlessly argues to include claim 34 for examination. The Election of Species requirement clearly set forth that claim 34 was presently considered generic to all species of the invention, and would be examined. It was newly added in reaction to the restriction requirement and successfully caused the restriction to be made moot with respect to the article claims. However, this is where the success of applicant's arguments on the linking issue ends. Under an election of species, different species become defined by various claim combinations, all of which can be seen as generic to a base claim in this case of claim 34, and to the same extent, newly added claim 33. This is what a generic claim is.

Cited MPEP sections 806.05 and 806.04 say exactly what the Examiner carried out in this case. These sections maintain that a restriction, not an election of species, is improper where there is a generic or linking claim involved. The cited section states only a restriction is improper, and not an election of species in this case. In fact, the section portion of this citation even suggests that the election of species should be carried out and the dependent non-elected claims allowed only when the generic claim is allowed. Albeit, the description of some species could have been elaborated more,

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i.e., claims 9-15 could better be said to cover a host computer with a receiver/transmitter, but this has not been raised, nor would it have any weight since the underlying combination still would be the same.

Accordingly, the species requirement is deemed proper and is made Final.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 33 are rejected under 35 U.S.C. 112, second/sixth paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear whether the applicant intends to invoke 112 sixth in the claims 1-8, 33 with regard to the functional language of the claims. It is required that applicant affirmatively assert or deny the intent to invoke 12 sixth paragraph for these claims.

Claims 2, 3, 4,5 6 only recite functional language without basing same on sufficient structural limitations. Claim 5 should be eliminated outright because is it attempting to claim a negative feature.

Claim6 it is not understood what remotely installed means, if something is installed, then it is installed coincidently with the other object.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 7,8 and 33 rejected under 35 U.S.C. 102(e) as being anticipated by Morris et al.

Morris et al. disclose an inventory agent (read as the part of the target device 112 which does not detect the inventory) comprising: a receiver (unit 112 has both a transmitter and receiver) for receiving a message from a client computer (130/118) through the data network (110); a detector for detecting inventory associated with the target device (scanner 22 of the target device 112 is read as detecting inventory), and a transmitter (unit 114 is both a transmitter and receiver) for transmitting through the data network (110)an inventory-data message ( message is the request from target 112). This reading is taken in light of Applicant's still unknown intention of invoking 112 sixth. Until such intention is made known, recitations following the word "for" or "used" are read as intended use, and while considered, are not given any weight. Re claim 33: host main frame 118 the computer processor, memory, and user interface of control server 130.

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Re claim 5: the upstream usage of the data from the device 112 in Morris et al is all automatic.

Re claim 7: SRAM stores dynamically loaded program overlays and data which is read as executable language as it is dynamic.

Re claim 8: the executable language statements are disclosed as being SQL statements, see col. 7 lines 49-50.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 33,34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al. in view of DeLaHuerga et al.

Morris et al. Disclose the invention substantially as claimed as et forth above. However, assuming that applicant is invoking 112 6<sup>th</sup> paragraph for the functional language claims 1-8, 33 and the means plus function language of claim 34, fail to disclose a system wherein an agent receives a message from the client computer to effect uploading of data to the master database. DeLaHuerga et al. do disclose this feature wherein the ICD 10 ( target device) conducts data transfer to host/client

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computer 60 (col. 24 lines 48 et seq.) only after the computer sends an inventory commence message e.g. interrogation signal (col. 22, lines 42 et seq.) to the target device 10. It would appear obvious to modify the Morris et al. system to include host or client computer initiated data upload as taught by DeLaHuerga et al. because the motivation for this would be to have the client or host computer control data uploading to e.g., at a time better suited to accommodate the requirements of the host computer for example band width conservation.

Claims 2/3: insofar as sufficient structure were to be recited, col. 7, lines 41 et seq. in Morris et al. disclose each message includes an ID indicating that compares the inventory agent and it would be obvious to use this feature in a receiver rather than at the computer where the agent is being interrogated as taught by DeLaHuerga et al.

Re claim 3: insofar sufficient structure were to be recited, see DeLAHuerga et al. for teaching of terminating if ID is not recognized Col. 23 lines 35 et seq.)

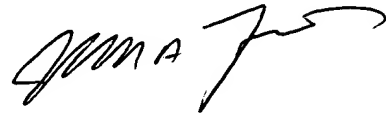
Re claim 4: the initiation of data transfer upon re-accessing the network is deemed an old expedient in the art, and official notice is taken regarding the same each time a PC boots up it retrieves memory from

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to PRIMARY EXAMINER Joseph A. Fischetti at telephone number (703) 305-0731.

A handwritten signature in black ink, appearing to read "J A Fischetti", with a stylized flourish at the end.